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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,066	03/12/2001	Michael Safdeye	0851/01118	7498

7590

03/16/2004

ALAN ISRAEL, ESQ.
KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMILLER/ P.C.
489 FIFTH AVENUE
NEW YORK, NY 10017

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

29

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,066

Applicant(s)

SAFDEYE *Ch*

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE and amendment filed August 8, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12, 15-17, 33-36 and 39-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-12, 15-17 and 19-46 is/are allowed.
- 6) ☒ Claim(s) 47-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on August 8, 2003 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 61 and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 61 contains the phrase "wherein the exterior cover includes a portion that extends around and underneath an edge of the lower that is in contact with the lower" which renders the claim vague and indefinite. It is not

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clear what is in contact with the lower. Claim 70 contains the phrase "includes a ground contacting portion the shaped fabric member" which renders the claim vague and indefinite. It is not clear as to what this fragmented sentence is meant to encompass.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 47-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Grosjean 1,587,377. Grosjean '377 discloses all the limitations of the claims including the following: an outsole (Figure 1) having a backing part 2 of a shape-retaining moldable material; the backing part having a non-ground contacting portion (top portion facing foot) and a ground contacting portion (that shown as the border in Figure 1); a ground contacting fabric part 1 that is retained and held in place by the non-ground contacting portion of the backing part (see Figures 1 and 2); the backing part being imbedded in the fabric part to resist separation of the fabric (see col. Lines

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92-95), also page 2, col. 1, lines 15-41) ; the ground contacting portion of the backing part is free of fabric (see border in Figure 1); the backing part has a visible bare region uncovered by the fabric (border in Figure 1); the backing part and the fabric part are a component for shoe assembly (makes the outer sole); the moldable material is a thermoplastic (rubber is thermoplastic); the outsole has a ground contacting surface that comprises the ground contacting fabric part 1 and the ground contacting portion of the backing part (border of Figure 1); the fabric part occupies more than 50% of the ground contacting surface of the outsole (see Figure 1); the moldable material extends around a perimeter of the fabric material (See Figure 1); the fabric part includes a peripheral edge and at least a portion of the peripheral edge is disposed along the backing part so as to be ground contacting (see Figure 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 52-55 and 63-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grosjean 1,587,377 as applied above in view of Walters 384,483. Grosjean '377 discloses substantially all the limitations of the claims as noted above including the fabric material having a ground contacting pattern occupying more than 50% of the ground contacting surface of the outsole (see pattern in Figure 1); the shaped fabric member being disposed on the ball portion of the outsole (see Figure 1) and oriented away from the upper so as to engage the ground when the shoe is in use; the heel depending from the outsole and having a bottommost portion that engages the ground when the shoe is in use (see Figure 2, turned sideways to show what it would look like when contacting the ground); the heel 4 integrally formed as a part of the outsole; the ball portion engages the ground surface when the shoe is in use and the shank is angled upwardly and away from the ground surface when the bottommost portion of the heel and the ball are seated against the ground surface (see Figure 2); the shaped fabric member on the ball portion has a prescribed ground contacting pattern (See pattern in Figure 1); the backing part and the shaped fabric member comprise an integral assembly (see Figure 2); and the

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fabric member occupies greater than 50% of the ground contacting surface. Grosjean '377 does not disclose the upper attached to the sole, a connection between the upper and the outsole along a visible bare region of the backing part that is free of the shaped fabric member, the bottommost portion of the heel having a shaped rubber pad. Walters '483 teaches that an upper can be attached to a sole with a fabric contact surface at the area where the fabric is not on the bottom surface (see Figures 1-3). Walters '483 also teaches that the bottommost portion of the heel can have a shaped rubber pad b' to aid in cushioning of the impact of the user's foot with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to attach an upper to the sole in the bare area of the sole, as taught by Walters '483, to allow for the use of the sole on a shoe. It also would have been obvious to place a rubber pad, such as that taught by Walters '483, on the heel of the shoe of Grosjean '377 to aid in cushioning the impact of the user's heel with the ground during use.

8. Claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 55 above in view of Davis et al. 3,642,563. The references as

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applied to claim 55 above disclose all the limitations of the claims except for the upper having an exterior cover and a foam layer with the cover being made of fabric. Davis et al. '563 teaches that an upper attached to a sole can be made of a foam layer that is covered with a fabric (see Abstract and claim 1) to allow for attachment of the sole to the user's foot and to provide a suitable upper for shoes having cast or molded rubber or plastic soles and allow the user's foot to breathe (see col. 1, lines 35-51). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an upper made of fabric and foam, as taught by Davis et al. '563, to allow for attachment of the sole to the user's foot and to allow for the user's foot to breathe.

9. Claims 58-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 55 and 56 above in view of Ganon 5,012,541. The references as applied to claims 55 and 56 disclose all the limitations of the claims except for the foam layer including a fabric backing and this combination stitched to the cover, a lower having multiple layers, the upper extending under an edge of the lower and adhesively secured thereto. Ganon '541 teaches that the upper of a shoe can have a fabric backed foam attached to a cover made of

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fabric (60, 62, 64) with these layers stitched and adhered together (see Figures 5-32 and col. 2, lines 18-28) to prevent separation of the layers. Ganon also teaches that the shoe can have a lower 70b, 84 made of multiple layers and attached to the upper by having the upper extend under the edge of the lower and being adhesively secured and stitched thereto. This allows for securement of the upper to the lower without a last and to give a more rounded look while not compressing the material during manufacture. Therefore, it would have been obvious to attach an upper and lower, such as that taught by Ganon, on the sole of the references as applied to claims 55 and 56 above, to give the shoe a more rounded look without compressing the material of the shoe.

10. Claim 72 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 55 above in view of Schiller 5,012,596. The references as applied to claim 55 above disclose all the limitations of the claim except for the upper having a the strap extending across an upper portion of a foot and an ankle strap that includes means for securing the ankle strap to the user's ankle. Schiller teaches that a shoe with a sole can be provided with an upper that includes a toe strap 12 and an ankle strap 45 with the ankle strap having

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means to secure the strap about a user's ankle (see Figures 1 and 2, buckle) to allow for the user to fasten the sole to the user's foot. Therefore, it would have been obvious to make the upper of the references as applied to claim 55 above with a toe strap and ankle strap, as taught by Schiller, to allow for the user to strap the sole to her foot while allowing for the least amount of material to contact the user's foot, thereby allowing the foot to breathe.

Allowable Subject Matter

11. Claims 2-12, 15-17, 33-36, 39-46 are allowed over the prior art of record.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such

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papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

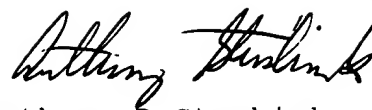
If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/

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Anthony D Stashick
Primary Examiner
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ADS

March 10, 2004